UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,466	11/08/2001	Erik Ekkel	US 018178 (D8333-09)	4995

	7590	08/08/2006	EXAMINER

Larry Liberchuck
Philips Electronics N.A. Corporation
P.O. Box 3001
Briarcliff Manor, NY 10510-8001

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/006,466	EKKEL, ERIK
		Examiner	Art Unit
		Neveen Abel-Jalil	2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 May 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) <u>9-20</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-8, 21-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   The Amendment filed on May 26, 2006 has been received and entered. Claims 1-26 are

pending.

Election by Original Presentation

2.   Newly Amended claims 9-20 are directed to an invention that is independent or distinct

from the invention originally claimed for the following reasons:

The original presentation prior to amendment was directed to using any existing peer-to-

peer secure architecture for access of files. While, newly amended claims 9-20 appear to be

directed to initialization and building of a specific system and not the using the general system of

claim 1. As such, it appears as though, the original scope of the invention represented in claims

1-8, and 21-26. Therefore, claims 1-8, and 21-26 are considered for Examination.

Since applicant has received an action on the merits for the originally presented

invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 9-20 are withdrawn from consideration as being directed to a

non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

3.   Claims 1, 4, 21, 22, and 24 are objected to because of the following informalities:

Independent claims 1, 4, and 21, and dependent claim 26, recite the limitaion "software operable for" is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight. Appropriate correction is required.

The Examiner points to MPEP 2106 II. C. wherein the claim's recitation of "software operable for" raises the question to Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Office personnel must rely on the applicant's disclosure to properly determine the meaning of "software operable for" in the claims. Limitations appearing in the specification but not recited in the claim are not read into the claim; therefore, in this case, the recitation of "operable for" as interpreted in light of the specification provide the "functionality" or "the capability" of the database management system to perform the steps without definite disclosure limiting or excluding any alternative, negative, or even all together suggest actually performing or implementing the functionality that is database management system is capable of.

Therefore, any cited art that teaches the steps otherwise in the alternative can be used to reject the instant application. The computer being capable to perform a function does not mean that it will ever actually perform that functionality. Furthermore, "for" is intended use recitation never having to take place making the limitations following have no patentable weight (i.e. "operable for" should be clarified and changed to a more definite term i.e. "configured to").

In claims 1, 4, and 21, the recitation of "enabling" has similar deficiency (could be changed to providing users of the software access to manipulate the data files).

Claims 1, line 5, and line 9, recite "operatively connected to" which is passive recitation suggesting if no operation is taking place, a connection will not be made either. Claims should be amended to recite "coupled to" or "configured to". Similarly, claims 4, and 21 have the same deficiency. Correction is appreciated.

Claims 1, line 21; claim 4, lines 24 and 26; claim 21, line 14; and claim 26, line 5, recite "so that", "thereby", and "for authorized access" which constitute intended use making the functionality following not carry any patentable weight since it never actually have to take place. Claims should be amended to recite more direct and positive language such as "is" or "to prevent" or "making" or "that". Correction is required.

Claims 22, and 24, recite an "if" statement which suggest optionally, passive recitation. If the Applicant intended to have the remaining limitations after the "if" statement to be considered fully and given complete patentable weight. The "if" recitation should be changed to recite more firm and definite language (i.e. wherein/when/which). Since "if" statement is optional, the remaining limitation does not necessarily have to happen (i.e. the detection of unidentified system). Appropriate correction is required.

Claims 1, 4, and 22, recite "to effect" which is passive and indirect suggestion an effect to happen but not necessarily taking place. Claims should be amended to recite more direct language such as "implemented" or "to provide".

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claims 1, 4, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 4, and 21 are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application (see MPEP 2106 IV.B.2.(b)). The definitions given in the specification for a system is broad enough so as to not include a practical application of computer system (see paragraph 0014 "maybe computer"), and no tangible result is produced in the claims. The use of a computer has not been indicated. The claims should be amended so that some kind of hardware is required (computer system) and/or so a tangible result is produced.

In claims 1, and 21, the final limitaion of "enabling" does not produce tangible results since it never actually have to take place. Accessing, storing, or presenting is tangible concrete results.

In claim 4, the final limitation of "securing the data files for authorized access" does not produce an outcome or tangible results. Since securing is not stored or presented to the users and the "for access" is intended use.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 1, 4, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 recites the limitation "enabling users of the software to manipulate the data files"

in the final limitation of the claim, which is vague and unclear since the preamble and the rest of

the claimed limitation appear to be directed to peer-to-peer devices and not to human users.

Unless this limitation is stating "user" are the other "peer" devices in the network? In which case

clarification is required. It is unclear who the user is? And to what extent they use the

"manipulation"? Is it granting full access to content vs. read only access? Or given authority for

download and storage for subsequent access?

Claim 21 has similar deficiency.

Claim 4 appears to be direct to intended use of "for authorized access" in the last

sentence of the claim, which carries no patentable weight. Thus being left with the recitation of

"securing" which too falls under the above rational. Whose doing the securing, and what does

the securing entail? And to what end?

8.   Claim 5 is rejected under 112 2nd because the phrase "and/or" renders the claim indefinite

since its unclear why the applicant is making a distinction if the intention is all along to include

both instances of the limitaion or its alternative.

9.   Claim 4 recites the limitation "the predetermined data format" in line 25. There is

insufficient antecedent basis for this limitation in the claim.

8.   Claims 1, 4, and 21, all recite the limitation "software executing in the music box" in line

13, which renders the claims vague and indefinite for lack of any prior mention of how or by

what means is the software executing in the music box? There was never an indication that the

music box is computer-implemented hardware (residing in a computer) configured to store and

execute software. Furthermore, there was no definition given in the claim as to what constitute

"authorized music boxes" since that can range from registered hardware to encrypted file.

Clarification is required.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this
> or a foreign country, before the invention thereof by the applicant for a patent.

10.   Claims 1, 3-7, and 21-26 are rejected under 35 U.S.C. 102(a) as being anticipated by

Dukyun Nam, et al. *Distributed Document Sharing System*. June 2001 (hereon in Nam at al.).

As to claim 1, Nam at al. discloses a system for peer-to-peer access to a collection of

data, comprising:

a musicbox (See page 1) comprising:

a persistent data store, the persistent data store containing a plurality of individually selectable data files of a predetermined data format, some of the data files being pre-loaded onto the persistent data store (See page 11, paragraph 2);

a data communications interface operatively connected to a data communications network to effect a peer-to-peer network, the data communications network comprising a plurality of musicboxes authorized to participate in the peer-to-peer network (See page 1); and

a controller operatively connected to the persistent data store and the data communications interface (See page 3, paragraph 5); and

software executing in the musicbox (See page 1, also see page 9, paragraph 2), the software being operable for:

identifying, without utilizing a central server, the plurality of authorized musicboxes executing instances of the software (See page 13, paragraph 1, also see page 9, paragraph 1, once registration takes place, a peer is allowed to communicate directly with another w/o server access);

peer-to-peer sharing the data files with the identified other musicboxes, the sharing being restricted to the identified plurality of authorized musicboxes having authorization to participate in the peer-to-peer sharing of data files (See page 9, paragraph 1);

securing the data files from unauthorized access, so that the data files are prevented from being retrieved in a perceptible format thereof by unauthorized musicboxes (See page 11, paragraph 2);

reproducing the data files into a predetermined perceptible format (See page 2, paragraph 1); and

enabling users of the software to manipulate the data files (See page 10, paragraph 1).

As to claim 3, <u>Nam at al.</u> discloses wherein the data files comprise at least **one of**
audiovisual works, music recordings, performance recordings, digitized film recordings,
digitized video recordings, graphic work images, text (See page 3, paragraph 4), and software.

As to claim 4, <u>Nam at al.</u> discloses a system for peer-to-peer access to a collection of
data, comprising:

a musicbox (See page 1) comprising:

a persistent data store, the persistent data store containing a plurality of individually
selectable data files of a predetermined data format, some of the data files being pre-loaded onto
the persistent data store (See page 11, paragraph 2);

a data communications interface operatively connected to a data communications
network to effect a peer-to-peer network (See page 1); and

a controller operatively connected to the persistent data store and the data
communications interface (See page 3, paragraph 5); and

software executing in the musicbox (See page 1, also see page 9, paragraph 2), the
software being operable for:

identifying, without utilizing a central server, other musicboxes executing instances of
the software (See page 13, paragraph 1, also see page 9, paragraph 1, once registration takes
place, a peer is allowed to communicate directly with another w/o server access);

peer-to-peer sharing of data files with the identified other musicboxes, the sharing being

restricted to the identified other musicboxes having authorization to participate in the peer-to-

peer sharing of data files (See page 9, paragraph 1);

securing the data files from unauthorized access (See page 11, paragraph 2);

reproducing the data files into a predetermined perceptible format (See page 2, paragraph

1); and

enabling users of the software to manipulate the data files (See page 10, paragraph 1),

wherein said software is configured to perform the securing files from unauthorized access by

selecting at least securing the data file from unauthorized copying, thereby preventing the data

files from being retrieved in the predetermined data format by unauthorized musicboxes (See

page 2, paragraph 2, wherein "copying" reads on "download"); and

securing the data files for authorized access (See page 11, paragraph 2) .

As to claim 5, Nam at al. discloses further comprising an audio-visual interface to export

audio and/or visual data for further reproduction of content within the data files (See page 9,

Figure A.1. Prototype Registration, shows different documents that are sharable which are

deemed to include audio/video).

As to claim 6, Nam at al. discloses wherein the musicbox is selected from at least one of

specialized musicbox devices and personal computers (See page 9, paragraph 3, wherein

"personal computers" reads on "client").

As to claim 7, <u>Nam at al.</u> discloses further comprising a central server to provide

registration services, the central server being a peer participant in the peer-to-peer network (See

page 9, paragraph 1).

As to claim 21, <u>Nam at al.</u> discloses a system for peer-to-peer access to a collection of

data, comprising:

means for storing persistent data, the persistent data comprising a plurality of data files of

a predetermined data format, the data files further being secured from unauthorized access (See

page 11, paragraph 2);

means for data communications, operatively connected to the means for storing persistent

data (See page 10, paragraph 2); and

means for accessing the persistent data, operatively in communication with the means for

storing persistent data and the means for data communications (See page 9, paragraph 3), the

means for accessing the persistent data being operable for:

identifying, without utilizing a central server, other systems executing the means for

accessing the persistent data (See page 13, paragraph 1, also see page 9, paragraph 1, once

registration takes place, a peer is allowed to communicate directly with another w/o server

access);

peer-to-peer sharing of the persistent data with the identified other systems, the sharing

being restricted to the identified other systems so that the persistent data is prevented from being

retrieved in the predetermined data format from the identified systems by an unidentified system

(See page 11, paragraph 2); and

enabling users of the means for accessing the persistent data to manipulate the persistent

data (See page 10, paragraph 1).

As to claim 23, <u>Nam at al.</u> discloses wherein said system does not include a central server

(See page 9, paragraph 1).

As to claim 24, <u>Nam at al.</u> discloses detecting whether a given musicbox of said other

musicboxes is executing said software (See page 20, paragraph 2, wherein "executing instance"

is read on "socket connection"); and

identifying said given musicbox as not being a peer if it is detected that said given

musicbox is not executing an instance of said software (See page 9, paragraph 2).

As to claim 25, <u>Nam at al.</u> discloses wherein said system does not include a central server

(See page 9, paragraph 1).

As to claim 26, <u>Nam at al.</u> discloses wherein said software is further operable for:

securing a predetermined collection of data files from unauthorized copying (See page 5,

paragraph 1, wherein "copying" reads on "downloading"); and

securing a predetermined collection of data files for authorized access.(See page 9,

paragraph 3).

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> ⸵ having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

13.   Claims 2, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dukyun

Nam, et al. *Distributed Document Sharing System*. June 2001 (hereon in Nam at al.) in view of

Pearson (U.S. Pub. No. 2003/0028610 A1).

As to claim 2, Nam at al. does not teach wherein the data files comprise works subject to

copyright and workings not subject to copyright.

Pearson teaches wherein the data files comprise works subject to copyright and workings

not subject to copyright (See Pearson page 6, paragraph 0045).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the invention of Nam at al. with the teachings of Pearson to

include wherein the data files comprise works subject to copyright and workings not subject to

copyright because it enforce copyrights and access restrictions (See Pearson page 1, paragraph

0005).

As to claim 8, Nam at al. does not teach comprising an authorization device, comprising

at least one of an electronic smart card, a mechanical smart card, and an optical key smart card.

Pearson teaches comprising an authorization device, comprising at least one of an electronic smart card, a mechanical smart card, and an optical key smart card (See Pearson page 6, paragraph 0042).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Nam at al. with the teachings of Pearson to include comprising an authorization device, comprising at least one of an electronic smart card, a mechanical smart card, and an optical key smart card because it enforce copyrights and access restrictions (See Pearson page 1, paragraph 0005).

Allowable Subject Matter

14.   Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form overcoming the claim objection and including all of the limitations of the base claim and any intervening claims.

Response to Arguments

15.   Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

17.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
August 6, 2006

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER